

specification and claim 1. Claims 1-11 are pending, although claims 2-7 have been withdrawn from further consideration as drawn to a non-elected Group.

Examiner Northington is thanked for the courtesy extended to the undersigned during a telephonic interview held on July 7, 1987. During the interview she agreed that amending the definition of "m" to delete "1" would overcome the §102(b) rejection of claims 1 and 8-10 over Sallmann. The substance of the remainder of the interview is set forth in the remarks below.

Applicants hereby affirm their election of the claims of Group III. However, the Restriction Requirement is respectfully traversed, since the subject matter of claim 1 does not lack unity of invention. All of the Markush members of claim 1 share both a common pharmaceutical utility and a common feature (the diclofenac radical) which is essential to that utility. See MPEP §803.02.

The Restriction Requirement between the process claims of Group IV and product claim 1 (Groups I-III) is respectfully traversed, as no showing has been made that the product as claimed can be made by another and materially different process. The various processes for making the diclofenac compound, disclosed in U.S. Patent 3,558,690 at columns 4-7, do not disclose materially different processes for making the claimed diclofenac salt. See, M.P.E.P. §806.05(f).

Reconsideration and withdrawal of the Restriction Requirement are earnestly requested.

The §102(b) rejection of claim 1 is overcome by the amendment of the definition of "m" appearing in claim 1. Reconsideration and withdrawal of the §102(b) rejection of claim 1 are respectfully requested.

The §103 rejection of claims 1 and 8-10 over Sallmann et al is respectfully traversed, as there is no teaching or suggestion within the reference which would lead one of ordinary skill in the art to the claimed water soluble salts of diclofenac. An important advantage of the present invention is that these salts are water soluble, and thus may be used as an aqueous solution rather than in tablet form. The use of a aqueous solution dosage form significantly reduces the risk of gastrolesion (specification, page 2, lines 7-15). Sallmann et al merely disclose pharmaceutically acceptable salts derived from a laundry list of nontoxic inorganic and organic bases, and disclose that the diclofenac compound may be administered in various dosage forms such as tablets, powders, suspensions and solutions (col. 3, lines 1-66). There is no teaching that the claimed cyclic organic bases will react with diclofenac to form salts which are water soluble.

The Examiner's attention is drawn to the comparative solubility data reported on page 3, lines 3-13 of the specification, which shows the surprising solubility of the claimed salts in comparison to other diclofenac salts, including the pyrrolidine salt, disclosed in Sallmann et al.

§103 requires that the patentability determination be made at a point in time just prior to the making of the claimed invention, without benefit of hindsight. In the present case, there is no suggestion within Sallmann et al which would lead one of ordinary skill in the art to the claimed diclofenac salts. Reconsideration and withdrawal of the §103 rejection of claims 1 and 8-10 are respectfully requested.

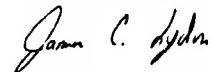
Claims 1 and 8-10 have been amended to overcome the §112 rejections thereof by deletion of the terms "containing" and

"characterized", and the phrase "to form a solution". Claims 2-7 have also been amended accordingly. The requirement of an intended use is respectfully traversed, since Applicants are claiming a composition rather than a method for treating inflammation. Reconsideration and withdrawal of the §112 rejection of claims 1 and 8-10 are respectfully requested.

An Information Disclosure Statement accompanies this Amendment.

It is believed the application is in condition for allowance. Reconsideration and withdrawal of the Restriction Requirement, all rejections of claims 1 and 8-10, and issuance of a Notice of Allowance directed to claims 1-11, are respectfully requested. The Examiner is encouraged to telephone the undersigned should she believe applicants could be of assistance in placing the application in even better condition for issue.

Respectfully submitted,



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